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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,325	12/01/2003	Kai Desinger	3001	3655

7590 09/27/2007  
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EXAMINER
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PAPAPIETRO, JACQUELINE M

ART UNIT	PAPER NUMBER
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3739

MAIL DATE	DELIVERY MODE
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09/27/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/726,325

Applicant(s)

DESINGER, KAI

Examiner

Jacqueline Papapietro

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2004 and 01 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☒ Claim(s) 6 and 7 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. PCT/EP02/05766.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date Dec 13 2004.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Objections***

Claims 6 and 7 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim must refer back in the alternative only and cannot refer back to another multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the system" in line 9 of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim 2 recites the limitation "the surgical instrument" in lines 1-2 of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim 3 recites the limitation "a power source" in line 2 of the claim. It is unclear if Applicant is claiming a new power source, or referring to the power source claimed in line 3 of claim 1.

Art Unit: 3739

Claim 3 recites the limitation "the detector" in line 3 of the claim. Claim 3 depends from claim 1 or claim 2; however, there is insufficient antecedent basis for this limitation in the claim when claim 3 depends from claim 1.

Claim 5 recites the limitation "an initial application" in line 2 of the claim. It is unclear if this is the same initial application recited in line 4 of claim 3, or a different and distinct application.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by McCartan et al (US 6270460 B1).

McCartan discloses an electrically operated medical product (ultrasound probe 202) for use at and in the patient, characterized by a reuse blocking device (fuse circuit, Figs 3a and 3b) which is connectable to the power source and is designed in such a way that when the product is brought into electrical operation for the first time, the reuse blocking device is so initialized and is so altered in its state that operation of the medical product is possible as long as the medical product is connected to the power source or the power source is switched on or is active and the reuse blocking device prevents renewed operational use of the system after disconnection from the power source

Art Unit: 3739

(column 3 lines 58-67; column 5); characterized in that the reuse blocking device includes at least one ohmic resistor (R1-R5, Fig 5a) which, when the surgical instrument is first brought into operation, is altered in its resistance or destroyed (Step 614, Fig 6), and a detector (Step 604, Fig 6) which responds to a deviation in the resistance value from a predetermined range of values and triggers the reuse blocking device so that the medical product is prevented from being brought into operation; comprising an electrically operated probe (ultrasound probe 202) which is connected to a generator as a power source with an electronic monitoring means (column 5 lines 5-7) which includes the detector, wherein bringing the probe into electrical operation for the first time represents an initial application, characterized by a configuration of the probe and the electronic monitoring means such that each initial application leads to a change in state at the probe (i.e. blowing a fuse), which is caused by the electronic monitoring means in the generator (see Fig 6); characterized in that the electronic monitoring means is adapted to switch off an output of the generator upon the attainment of a predetermined state of the probe prior to the initial application (Step 608, Fig 6); characterized in that the electronic monitoring means is designed in such a way that after an initial application has been implemented the probe can be used as often as desired by the user as long as the probe is still connected to the generator and said generator is switched on (column 3 lines 58-67).

**Conclusion**

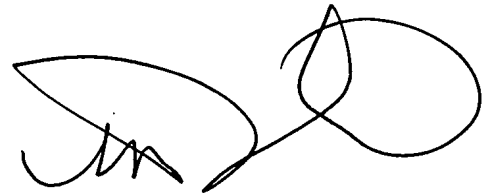
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacqueline Papapietro whose telephone number is (571) 272-1546. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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Art Unit 3739



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